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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,103	06/25/2001	Takahiro Ishizuka	003510-099	7294

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,103

Applicant(s)

ISHIZUKA, TAKAHIRO

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7,9-11,13-17 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7,9-11,13-17 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 9/9/05.

However, upon reconsideration of the claims, new grounds of rejection are set forth below and thus, the following action is non-final.

Claim Objections

2. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 14, which depends on claim 21, recites that the colored particulates are prepared by emulsification by one of pouring water into an organic solvent phase containing the block copolymer and the oil-soluble dye or pouring the organic solvent phase into water. Claim 21 recites the method comprising emulsifying and making into particulates an organic solvent phase, which contains block copolymer and the oil-soluble dye, by either adding water to the organic solvent phase or adding organic solvent phase into water. Thus, claim 14 fails to further limit the claim on which it depends, namely claim 21, given that claim 14 appears to recite the same method as claim 21. That is, claim 14 recites method of making colored particles which method is already disclosed in claim 21. Thus, claim 14 fails to further limit the scope of claim 21.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3-7, 9-11, 13-17, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 recites “a co-emulsification dispersion method for producing an ink jet ink”. It is the examiner’s position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Claim 21 was added in the amendment filed 8/21/03. As support for such addition, applicants pointed to page 52, lines 3-9 of the present specification. However, upon reconsideration, it is the examiner’s position that while this portion of the specification provides support to recite that the colored particulate dispersion of the present invention is prepared by co-emulsification dispersion method, this does not provide support to recite that the ink is prepared by co-emulsification method. That is, there is no support in the specification as originally filed to recite co-emulsification method for producing an ink jet ink, there is only support to recite co-emulsification method for producing colored particulate dispersion.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-7, 9-11, 13-17, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 6, which depends on claim 21, recites that the block copolymer is formed from a hydrophobic segment A and a hydrophilic segment B while claim 21 also recites that the block copolymer is formed from a hydrophobic segment and a hydrophilic segment. In light of the claim language of claim 6, i.e. "a hydrophobic segment and "a" hydrophilic segment, the scope of claim 6 is confusing because it is not clear if the hydrophobic segment and the hydrophilic segment of claim 6 are the same or different from the hydrophobic segment and hydrophilic segment of claim 21. If they are the same, it is suggested that claim 6 is amended, for instance, to recite "wherein the block copolymer is AB type, B¹AB² type, or A¹BA² type, where A¹ and A² maybe the same or different, B¹ and B² may be the same or different and wherein A is the hydrophobic segment and B is the hydrophilic segment".

(b) Claim 10, which depends on claim 21, recites the limitation "the vinyl monomer" and "the hydrophobic segment A" in line 3. There is insufficient antecedent basis for this limitation in the claim given that there is no disclosure of vinyl monomer or hydrophobic segment A in claim 21.

(c) Claim 14, which depends on claim 21, recites that the colored particulates are prepared by emulsification by one of pouring water into an organic solvent phase containing the block copolymer and the oil-soluble dye or pouring the organic solvent phase into water. Claim 21 recites the method, i.e. referring to making the ink, comprising emulsifying and making into particulates an organic solvent phase, which contains block copolymer and the oil-soluble dye, by either adding water to the organic solvent phase or adding organic solvent phase into water. Thus, the scope of claim 14 is confusing because it is not clear if claim 14 refers to making colored particulates that is in addition to the method steps described in claim 21 as cited above or if the method disclosed in claim 14 is the same as that disclosed in claim 21. Clarification is requested.


(d) Claim 21 recites “wherein the method comprises emulsifying and making into particulates an organic solvent phase, which contains block copolymer and the oil-soluble dye, by either adding water to the organic solvent phase or adding organic solvent phase into water”. The scope of the claim is confusing given that the above phrase refers to method of producing the ink while the steps recited appear to refer to method for producing colored particulates. Thus, the scope of the claim is confusing because it is not clear what is being claimed, a method of making the ink or a method of making the colored particulates. Clarification is requested.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

Art Unit: 1714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
12/9/05